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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,405	11/14/2001	Toshiaki Miyagi	MA-509-US	7051

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT PAPER NUMBER

3629

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/987,405	Applicant(s) MIYAGI, TOSHIAKI	
	Examiner Jonathan Ouellette	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1, 4, 8, 10, 12, 15, and 17-22** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicant has amended the Independent Claims to read wherein the second destination is of a dealer who is under contract with a map information provider. However, the Independent Claims further state the second destination will require a charge. The Examiner suspects the Applicant simple forgot to change the order of the destinations throughout the claims, and will examine the claims assuming that the first destination requires a charge and the second destination is provided free of charge.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roden (US 5,970,477) in view of Nakano (US 6,957,250).**
5. As per **independent Claims 1, 4, 8, 10, 12, 15, and 17-22**, Roden discloses an information providing device (system, storage medium) for providing information based on user requests (Fig.5), in response to a request from a user terminal device through a network, comprising: means for registering a first destination (URL/information source) which a information provider originally selects (Fig.5, not in URL free zone), in addition to a second destination (web page/information source) of a dealer who is under contract with the information provider (Fig.5, in URL free zone); and means for checking whether the requested destination is the first destination or the second destination when the information of the requested destination is requested by the user terminal device (Fig.5), when the requested destination is checked as the second information, the information is provided free of charge (Fig.5, in URL free zone), wherein, when the requested destination is checked as the first destination (Fig.5, not in URL free zone – normal charges apply), the user terminal device is notified that the first destination requires a charge, receiving confirmation of a user's payment of the charge, confirming payment acceptance at the user terminal device, performing billing processing, and providing the information, wherein when refusal of payment of the charge is confirmed by the user terminal device, finishing a connection (if a user does not pay for a service – it is common business practice that the service will not be provided).

Art Unit: 3629

6. Roden fails to expressly disclose map information providing means for providing map information.
7. However, Nakano discloses a system for providing map information through the Internet based on user requests (C3-C4, Figs.4-5).
8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included map information providing means for providing map information, as disclosed by Nakano in the system disclosed by Roden, for the advantage of providing a map information providing system/method with the ability to increase customer service by providing users with a variety of information types.
9. As per Claim 2, Roden and Nakano disclose means for checking whether the requested destination is the first destination or the second destination when the map information of a destination is requested by the user terminal device (Roden: Fig.5 is the URL in the Free Zone).
10. As per Claims 3, 6, 9, 11, 13, and 16, Roden and Nakano disclose wherein said map information providing means creates and provides the map information with a mark attached to the corresponding destination when providing the map information (Nakano: C3-C4, Figs.4-5).
11. As per Claim 5, Roden and Nakano disclose wherein said map information providing means further includes a function of creating and providing the map information including all the destinations on the same map when there is a request for two or more destination requiring the map information (Nakano: C3-C4, Figs.4-5).

Art Unit: 3629

12. As per Claims 7 and 14, Roden and Nakano disclose wherein said map information providing means further includes a function of creating and providing the map information including all the destinations on the same map when there is a request for two or more destinations requiring the map information, and creates and provides the map information with a mark attached to the corresponding destination when providing the map information (Nakano: C3-C4, Figs.4-5).

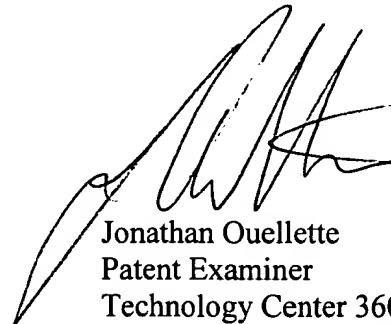
Response to Arguments

13. Applicant's arguments filed 6/8/2006, with respect to Claims 1-22, have been considered but are moot in view of the new ground(s) of rejection.
14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

August 15, 2006



Jonathan Ouellette
Patent Examiner
Technology Center 3600